

DOCKET NO.: CSKL0003-100**PATENT****REMARKS**

Claims 26-29 were pending in the present application. Claims 26, 28, and 29 have been amended herein. New claims 30-35 have been added, support for which can be found, for example, in Figures 8 and 11 of the original specification as filed. No new matter has been added. Upon entry of the present amendment, claims 26-35 will be pending.

As a preliminary matter, Applicants will submit shortly a new Declaration signed by each of the inventors. The Declaration will not contain a claim for priority.

I. The Claimed Invention Is Supported by Ample Written Description

Claims 26-29 are rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Office Action asserts that the specification lacks descriptive support for inhibiting division of any and all cell types, including a "helminth cell", a "cell involved in restenosis", a "cell involved in gout", and a "cell involved in myelodysplasia syndrome."

Although Applicants disagree, solely to advance prosecution of the present application, Applicants have amended the claims to recite particular cell types for which Applicants have ample support. For example, claim 26, as amended, recites the following cell types: leukemia cancer cell, a melanoma cancer cell, a renal cancer cell, a breast cancer cell, a non-small cell lung cancer cell, a colon cancer cell, a prostate cancer cell, and a lymphoma cancer cell. Each of these cell types are disclosed in the specification (see, for example, Figure 9).

In view of the foregoing, Applicants respectfully request that the rejection under 35 U.S.C. §112, first paragraph, as allegedly failing to provide sufficient written description be withdrawn.

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II. The Claimed Invention Is Sufficiently Enabled

Claims 26-29 are rejected under 35 U.S.C. §112, first paragraph as allegedly failing to provide an enabling disclosure. The Office Action mistakenly asserts that it would require undue experimentation for one skilled in the art to inhibit cell division in any and all cell types.

Again, although Applicants disagree, solely to advance prosecution of the present application, Applicants have amended the claims to recite particular cell types for which Applicants have quite clearly enabled. Applicants thank the Examiner for pointing out at page 6 of the Office Action that Applicants have, indeed, demonstrated inhibition of mitosis of a few cell types. No amount of undue experimentation is required in order to inhibit cell division in the cells recited in the claims.

Thus, there is no reason to believe that one skilled in the art would be required to perform any amount of undue experimentation to make and use the claimed invention. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §112, first paragraph be withdrawn.

III. The Claims Are Clear And Definite

Claims 26-29 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. The Office Action asserts that the claims are indefinite as to "whether an effective amount is used..." (see, page 13 of the Office Action).

Applicants remind the Examiner that the claims are directed to methods of "**inhibiting cell division** comprising contacting a cell with 3-iodoacetamido benzoyl ethyl ester (3-IAABE)." (emphasis added). Logic mandates that if the claim is directed to "**inhibiting cell division**", then the amount of 3-IAABE must be an amount that is effective to inhibit cell division -- one cannot inhibit cell division with an amount that is not effective to inhibit cell division. Solely to advance prosecution of the present invention, however, Applicants have amended claim 26 to recite "an effective amount of" 3-IAABE. No new matter has been added and the claims have not been narrowed. Further, persons of ordinary skill would have no difficulty in determining whether a particular amount of 3-IAABE is an effective amount to inhibit cell division. Accordingly, the

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claims are definite within the meaning of §112. *In re Mercier*, 185 U.S.P.Q. 774 (C.C.P.A. 1975) (claims sufficiently define an invention so long as one skilled in the art can determine what subject matter is or is not within the scope of the claims). Thus, the claims are clear and definite. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §112, second paragraph be withdrawn.

IV. Conclusion

In view of the foregoing, Applicants respectfully submit that the claims are in condition for allowance. An early notice of the same is earnestly solicited. The Examiner is invited to contact Applicants' undersigned representative at (215) 665-6914 if there are any questions regarding Applicants' claimed invention.

Respectfully submitted,



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Date: 26 January 2006

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